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OFFICE OF PETITIONS

In re Application of	:	
Allen J. NEJEZCHLEB et al.	:	DECISION
Application No. 09/987,769	:	ON PETITION
Filed: November 15, 2001	:	37 CFR 1.53(e)
Attorney Docket No. SAIC0020-CON	:	

This is a decision on the petition filed November 15, 2001¹, and the supplement thereto filed November 29, 2001, under 37 CFR 1.181, requesting that the above-captioned application be accorded a filing date of October 30, 2001, which is being treated under the provisions of 37 CFR 1.53(e) as requesting that the above-captioned application filed be accorded a filing date of October 30, 2001, instead of the currently accorded filing date of November 15, 2001.

The petition is DISMISSED. This is not a final agency action within the meaning of 5 U.S.C. §704.

The above-identified application papers were deposited with the USPTO on November 15, 2001. The Office of Initial Examination found these papers to be complete for purposes of according a filing date, and as such, assigned a filing date of November 15, 2001, to these papers.

Petitioner requests the earlier filing date on the grounds that because of the mail delays associated with the recent anthrax contamination of the U.S. Postal Service Brentwood Sorting Station, through which the USPTO's mail is routed, the Issue Notification in parent application No. 09/085,669 was neither docketed nor

¹The petition was resubmitted via facsimile on September 25, 2002.

received prior to the issue date of U.S. Patent 6,309,610. Consequently, the instant continuing application was not timely filed². Petitioner does not point to any USPTO error in according the current filing date.

Unfortunately, the requested relief simply cannot be granted, as such is beyond the scope of authority of the USPTO. 35 USC 111(a)(4) specifically states in pertinent part that:

The filing date of an application shall be the date on which the specification and any required drawings are received in the Patent and Trademark Office.

Since petitioner concedes that the above-identified specification was not received at the USPTO any earlier than November 15, 2001, that is the earliest filing date that can be accorded to the instant application. See 35 USC 111(a)(4). The statute does not accord a filing date to an application that was intended to have been filed.

Petitioner should note that MPEP §1306.03 has long contained the following caveat: "[b]ecause the Issue Notification may be mailed less than two weeks before the application is expected to issue as a patent, applicants are advised to file any continuing application **before** receiving the Issue Notification to avoid loss of copendency" (emphasis added). This section of the MPEP merely reflects the prior notices that members of the public and registered practitioners were given at "Patents to Issue More Quickly After Issue Fee Payment", 1220 *Off. Gaz. Pat. Office* 42 (March 9, 1999) which states, in pertinent part "[a]s part of the Patent and Trademark Office's changes in business practices to streamline its processing of patent applications, and thereby maximize patent term of patents, the PTO has established an objective to issue patents within four weeks of payment of the issue fee by July 1999 instead of the current average of three months;" and at "Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee", 1221 *Off. Gaz. Pat. Office* 14 (April 6, 1999) which states, in pertinent part: "Filing continuing applications: Since a continuing application (a continuation, divisional, or continuation-in-part) may be filed anytime before an application is

² Petitioner is apparently attempting to establish continuity between the instant application and parent application No. 09/085,669 in order to obtain the benefit of the filing date of the prior application pursuant to 37 CFR 1.120 although no claim is specifically made pursuant to 37 CFR 1.78 in the instant application.

patented or abandoned, applicants will often wait for the Issue Notification before filing such a continuing application. *Therefore, the PTO strongly advises applicants not to wait for receipt of an Issue Notification before filing any desired continuing application* [emphasis added]. This is because applicants will now receive the Issue Notification just shortly before the application will issue as a patent (when it may be too late to prepare and file a continuing application). Applicants are reminded that: (1) the requirement that there be copendency for an application to obtain any benefit of the filing date of the prior application is a statutory requirement (35 U.S.C. 120) which the PTO cannot waive; and (2) the patent statute contains no provisions for restoring a patented application (unlike an abandoned application) to pending status.

The PTO specifically advises practitioners to be prepared to file any desired application preferably no later than the date the issue fee is paid, to avoid issuance of the application before the continuing application is filed."

A review of Serial Number 09/085,669, with which petitioner is apparently attempting to establish continuity, reveals that the issue fee was paid on July 13, 2001. Notwithstanding the clear and unambiguous warnings forth in MPEP §1306.03³ and the *Official Gazette* notices published March 9, 1999 and April 6, 1999, since petitioner appears to have unfortunately continued the practice of waiting until receipt of the Issue Notification before preparation of a continuing application, petitioner can not now be heard to complain.

In any event, arguments that the delayed receipt of the Issue Notification may have been due to Postal Service Interruptions and caused a delayed filing of the instant application such that copendency could not be established are immaterial to the

³*Manual of Patent Examining Procedure* (MPEP), 8th Ed. (Aug. 2001). The MPEP has no binding force on the courts, but it commands notice as an official interpretation of statutes and regulations with which it does not conflict. Patent attorneys, examiners, and the public commonly rely on the MPEP as a guide in procedural matters. *In re Kaghan*, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967); *Syntex v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 1571 n.3, 11 USPQ2d 1866, 1867 n.3 (Fed. Cir. 1989); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1439, 221 USPQ 97, 107 (Fed. Cir. 1984).

earliest filing date that can be accorded to the instant application under the patent statute.⁴

This application is being forwarded to Technology Center 1700

Inquiries regarding this communication may be directed to B. Dayoan at (703) 308-3865 or, in her absence, to the undersigned at (703) 305-1820.



Brian Hearn

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Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy

⁴ The USPTO lacks the discretion or the authority to contravene any requirement of the patent statute. Baxter Int'l. Inc. v. McGaw Inc., 149 F.3d 1321, 47 USPQ2d 1225 (Fed. Cir. 1998), That is, since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute. See A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977).